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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/837,129	04/18/2001	Misaki Ishida	3274-010528	7371

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EXAMINER	
WANG, SHENGJUN	
ART UNIT	**PAPER NUMBER**
1617	

DATE MAILED: 05/24/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/837,129	ISHIDA ET AL.	
	Examiner	Art Unit	
	Shengjun Wang	1617	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *11 March 2004*.

2a)☒ This action is **FINAL**. 2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-3 and 15-18* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-3,15-18* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Receipt of applicants' remarks submitted March 11, 2004 is acknowledged.

Claim Rejections 35 U.S.C. 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

2. Claims 1-3 and 15-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hadas et al. (GB 2,259,014, of record), in view of Swift (US 3,598,841, of recode), and JP 08337534, and in further view of Machida et al. (IDS AS) and Sarin at al. (IDS, AS) with respect to claims 15-18.

3. Hadas et al. teaches a composition for skin whitening comprising a flavonoid and ascorbic acid or its derivatives, wherein the flavonoid may be a plant extract. (see the abstract). Hadas further teaches that kojic acid enhances the whitening effect of flavonoid and ascorbic acid and its derivative through a synergistic effect (see page 19, lines 17-27). The composition may further comprise other well-known cosmetic ingredients. See the examples.

4. Hadas et al. does not teach expressly the employment of citrus unshiu extract as the source of flavonoid.

5. However, Swift teaches citrus peels is well known to containing significant amount of flavonoids herein employed. See, particularly, column 1, lines 31-35. JP 08337534 teaches that the organic extract of citrus unshiu is particularly useful for whitening skin. See, particularly, the abstract.

Therefore, it would have been prima facie obvious to a person of ordinary skill in the art, at the time the claimed the invention was made, to make a composition according to Hadas by employ the citrus unshiu extract.

A person of ordinary skill in the art would have been motivated to make a composition according to Hadas by employ the citrus unshiu extract because citrus unshiu extract is known to containing flavonoid herein, and is particularly known for the usefulness as skin whitening agent.

With respect to claim 15-18, which recited a method of preparing the extract, note it would have been an obvious alternative by employing a purified, or concentrated extract, to a crude extract. Purifying or concentrating a composition with known active ingredients is seen as a routine experiment, and would have been within the skill of artisan. See the entire documents of Machida et al. and Sarin at al., wherein flavonoids are concentrated, or purified by similar procedure herein employed, i.e., solvent extraction, and liquid chromatography.

Response to the Arguments

Applicants' amendments and remarks submitted March 11, 2004 have been fully considered, but are not persuasive for reasons discussed below.

Applicants argue that the cited references do not teach expressly the claimed process for obtaining the flavonoid from citrus, and therefore the claimed composition is not obvious over the cited references. Note "[E]ven though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process." In re Thorpe, 777 F.2d 695, 698,

227 USPQ 964, 966 (Fed. Cir. 1985). The instant claims are drawn to a cosmetic composition comprising flavonoids known for whitening the skin. A particular process of isolating such flavonoids would not make the final product patentable distinct from the cited prior art, particularly, in view the fact that the process of isolating the flavonoid is a routine procedure (extract with a polar organic solvent, partition between water and less polar organic solvent, and finely purified by chromatography), similar to those disclosed in the cited prior art.

6. In response to applicant's arguments against the references individually, one cannot show nonobviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.,* 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). Considered the cited references as a whole employ purified flavonoids from citrus unshihu or citrus tachibana as skin whiten ingredients in a cosmetic composition would have been obvious to one of ordinary skill in the art.

7. Note, JP'534 use the same crude extract as herein employed (ethanol extract of citrus tachibana),which would comprise all the active ingredients herein, but without the removal of impurity.

Applicants further contend that the cited references do not teach expressly the particular characteristics recited herein, note the claiming of a new use, new function or unknown property which is inherently present in the prior art does not necessarily make the claim patentable. In re Best, 562 F.2d 1252, 1254, 195 USPQ 430, 433 (CCPA 1977). A chemical composition and its properties are inseparable. Therefore, if the prior art teaches the identical chemical structure, the

properties applicant discloses and/or claims are necessarily present. In re Spada, 911 F.2d 705, 709, 15 USPQ2d 1655, 1658 (Fed. Cir. 1990).

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shengjun Wang, Ph.D. whose telephone number is (571)272-0632. The examiner can normally be reached on Monday-Friday from 8:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sreeni Padmanabhan, can be reached on (571)272-0629. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9302.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (571) 272-1600.

S. Wang

SHENGJUN WANG
PRIMARY EXAMINER